

REMARKS

New claims 30 and 31 are supported by original claims 1, 11, 28 and 29. Applicants thank the Examiner for withdrawing the anticipation rejection over WO '256.

The Examiner states that he has rejected claims 1, 2, 11-13, 16, 17 and 27-28 over WO '714 because Applicants deleted the limitation "said permeate water being optionally mixed with additional portion of feed water." See page 11, lines 3-5 of the Action. The Examiner reads "being optionally mixed" in claim 29 as "being mixed." Thus, consistent with the Examiner's reading of claim 29, "being optionally mixed" in claim 29 has been changed to "being mixed."

The pending rejections are as follows:

Claims 1, 2 and 27-29 were rejected as being anticipated by Uhlinger. Claims 1, 2, 11-13, 16, 17 and 27-28 were rejected as being anticipated by WO 99/16714 (WO '714). Claims 3-10 were rejected as being obvious over Uhlinger. Claims 11-13, 16 and 17 were rejected as being obvious over Uhlinger in view of WO '714. Claims 14 and 15 were rejected as being obvious over Uhlinger in view of WO '714, further in view of EP 0 709 130 A1 (EP '130). Claims 3-5 and 29 were rejected as being obvious over WO '714 in view of WO 01/14256 (WO '256). Claims 6-10 were rejected as being obvious over WO '714. Claims 14 and 15 were rejected as being obvious over WO '714 in view of WO '256, further in view of EP '130. These rejections are respectfully traversed.

At this point, the Examiner has applied Uhlinger and WO '714 for "inherently" disclosing a total salt concentration of about 55 to 77% of that of the feed water and a calcium ion concentration of about 95% or less of that of the feed water. See page 3, lines 1-3, and page 4, line 3 from the bottom to page 5, line 3, of the Action. Also, starting from page 6 of the Action, the Examiner has rejected several claims as being obvious as stated above, while still relying on Uhlinger or WO '714 as the primary reference.

Applicants respectfully submit that the Examiner's "inherency" arguments are totally without any basis to establish a *prima facie* case of inherent disclosure. As everyone knows, *it is impossible to prove or disprove something that does not exist*. On the other hand, it is very easy

for an examiner to allege inherent disclosure after failing to find any explicit disclosure of a claim limitation in a prior art reference. To prevent such gambits by the examiners, the United States patent law has set strict guidelines for the examiner to establish a *prima facie* case of inherent disclosure. Inherency requires that the claimed missing descriptive matter is *necessarily* present in the thing described in the reference. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is *not* sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted; emphasis added).

In the present case, the Examiner has *not* provided any basis in fact and/or technical reasoning to reasonably support the determination that a total salt concentration of about 55 to 77% of that of the feed water and a calcium ion concentration of about 95% or less of that of the feed water would necessarily occur in either Uhlinger or WO ‘714. If at all, this condition *might* occur in Uhlinger or WO ‘714, of which the Examiner is simply hypothesizing. However, the mere fact that a certain thing *may* result from a given set of circumstances is *not* sufficient, as explained above citing *In re Robertson*.

An additional requirement “[f]or inherent anticipation ... [is that] the ... [prior art reference] must have sufficiently *described and enabled at least one embodiment that necessarily featured or resulted in the subject matter embraced by [the missing] limitation*” that is alleged to be inherently disclosed in the prior art reference. *Toro Co. v. Deere Co.*, 355 F.3d 1313 (Fed. Cir. 2004) (hereafter, “*Toro*”) (emphasis added). Uhlinger and WO ‘714 does *not* even provide an enabling disclosure of any embodiment that necessarily would result in a total

salt concentration of about 55 to 77% of that of the feed water and a calcium ion concentration of about 95% or less of that of the feed water.

Please also notice that the Examiner has rejected claim 29 on page 9, paragraph 4, as being obvious over WO '714 in view of WO '256 "because WO '256 is an improvement over WO '714." This is too general a motivation to combine, which would apply to virtually any combination of prior art. The Examiner's selected motivation is, in fact, so general in the context of the relevant art that it constitutes no more than the reference to a general level of skill in the art found deficient in *In re Lee*, 277 F.3d, 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). As emphasized by the court in *In re Lee*, 61 USPQ2d at 1433, the Examiner must present specific evidence of motivation, not the generalized evidence relied on in the Action. Also, how does the Examiner know that WO '256 is an improvement over WO '714? Again, the Examiner is simply hypothesizing.

For the record, Applicants would like to state that the Examiner has simply taken official notice without providing any evidence to support inherent disclosure in Uhlinger or WO '714 and to argue that WO '256 is an improvement over WO '714. Particularly, in light of the decision in *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), MPEP 2144.03, specifically cautions examiners against taking official notice as the Examiner in this case has done:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. [Underlining in original.]

In light of the above, a Notice of Allowance is respectfully solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions

for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952**, reference No. **360842008300**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: December 3, 2004

Respectfully submitted,

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